

Response to Office Action  
Application No. 09/855,340

**Remarks:**

Claims 1, 6, 8-18, 21, and 24-26 are pending.  
Reconsideration of the claims is requested.

**Telephone Interview.** Applicants wish to thank Examiners Schlapkohl and McKelvey for conducting a telephone interview on August 12, 2005 with the undersigned. An interview summary was received from the Patent Office setting forth the Examiners' description of the substance of the interview.

During the interview, it was clarified that the rejection under 35 U.S.C. § 102(e) was on the basis of inherent anticipation. The issue of inherent anticipation of the instant claims by Hosted et al. was discussed. The Examiner took the position that although the claimed compositions are not specifically disclosed by Hosted et al., the claims are inherently anticipated. The undersigned argued that the disclosure of Hosted et al. was not sufficient to inherently anticipate the instant claims and that a *prima facie* case of inherent anticipation had not been made. A response, offered by the Examiner, to this argument was that a *prima facie* case had been made and that the Patent Office does not have the facilities to determine if the nucleotide sequences in pMLP1 of Hosted et al. were identical those of the instant claims. For this reason, argued the Examiner, the burden of showing otherwise is on the applicant.

**Claim rejection under 35 U.S.C. § 102(e).** Claims 1, 6, 8-18, 21 and 24-26 stand rejected as allegedly inherently anticipated by Hosted et al. (US 2004/0101832A1 and U.S. Patent No. 6,861,513). The Examiner alleges that

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since Hosted et al. teach construction, sequencing and use of *Xis*, a skilled artisan would expect the reference to necessarily teach a polynucleotide comprising the nucleotide sequence of SEQ ID NO: 2 or 6.

Applicants submit that the rejection should be withdrawn because Hosted et al. is not a prior art reference with respect to the instant application. The *Xis* gene sequence (SEQ ID NO: 2) and the *M. carbonacea* attP/attB region (SEQ ID NO: 6) were discovered before the January 12, 2000 priority date of the cited references. As evidence of this point, enclosed is a declaration under 37 C.F.R. § 1.131 ("Hosted Declaration"). The Declaration is by co-inventor Thomas J. Hosted (Hosted Declaration, ¶1). The claimed invention was invented before the January 12, 2000 priority date of the cited references (Hosted Declaration, ¶1 & 3). Exhibits A and B are copies of pages from co-inventor Hosted's laboratory notebook (Hosted Declaration, ¶2 & 4). The notebook pages show the sequences of the *Xis* gene and the *M. carbonacea* attP/attB region that were discovered (Hosted Declaration, ¶2 & 4).

Since the subject matter to which the claims are directed was invented before the priority date of the Hosted et al. references, withdrawal of the claim rejection is respectfully requested.


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**Conclusion**

The claims are in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,

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Date

  
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